

**REMARKS**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

This amendment is in response to the Non-Final Official Action dated April 17, 2008. Claim 1 has been amended, claims 2, 4 and 6 have been canceled; as such, claims 1, 3, 5, 7-28 are now pending in this application. Claim 1 is the independent claim. Reconsideration and allowance is requested in view of the claim amendments and the following remarks.

No new matter has been added by this Amendment. Support for the amended and new claims can be found in the specification as filed. For example, support for the feature described in connection with "the solute comprises selected from a carboxylic acid or a salt thereof and an inorganic acid or a salt thereof, and further comprises one or more compounds selected from a nitro compound" is found in paragraph 0045 of the specification published as US 2007/0121276 (hereinafter, the specification paragraph numbers refer to those of this publication).

**Opening Clarification**

Before getting the specific rejections of the Office Action, applicant will recite features of the present invention which are novel and will help in the examiner's understanding of the claims. According to the present invention, the water content of from more than 80% by weight to 100% by weight of the solvent is very important for the present invention, because the electrolytic solution of the present invention can provide excellent and stable capacitor characteristics as a result of controlled viscosity without causing a freezing problem of the solution, as is described in paragraphs 0031 and 0040 of the specification.

Further, such highly increased water content is effective to realize a flame-retardant, safe and cheap capacitor having no danger of catching fire, as described in paragraph 0155 of the specification.

Moreover, such water content is also effective to maintain the desired characteristics while satisfying the specific resistance of  $65\Omega\cdot\text{cm}$  or less, as described in paragraph 0028 of the specification.

In addition, the content of the carboxylic acid-based electrolytes of from 0.5 to 35% by weight is also very important for the present invention. As described in paragraphs 0027, 0029, 0030, and 0045 of the specification, the controlled content of the solute, especially carboxylic acid-based electrolyte is effective to stably maintain the characteristics at high temperature, and to attain long working life at a high temperature.

### **35 USC 102 Rejections**

1. Claim 1 has been rejected under 35 U.S.C. § 102(a) as being unpatentable over Komatsu (JP 2004-031983, hereinafter referred to as Komatsu '983). Applicant respectfully traverses this rejection.

Komatsu '983 discloses an electrolytic solution containing water in an amount of more than 80% by weight. However, **Komatsu '983 is silent concerning use of a carboxylic acid-based electrolyte as a solute in the amount of from 0.5 to 35% by weight of the electrolytic solution.** Please note that according to the present invention, such a limited concentration of the carboxylic acid-based electrolyte is used in order to achieve the remarkable effects of the present invention. Moreover, Komatsu '983 is directed to improving a separator used in the capacitor comprising an electrolytic solution containing water in an amount of more than 80% by weight.

Komatsu '983 therefore fails to teach or suggest various features of independent claim 1.. Furthermore, at least for the reason disclosed above, claims 3, 5, 7 and 10-11 overcome Komatsu '983 because they depend on independent claim 1.

Accordingly, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(a) be withdrawn.

2. Claim 1 has been rejected under 35 U.S.C. § 102(b) as being unpatentable over Komatsu (JP 2000-173871, hereinafter referred to as Komatsu '871). Applicant respectfully traverses this rejection.

Komatsu '871 discloses an electrolytic solution containing water in an amount of 80 to 20% by weight (claim 1) and carboxylic acid or salt thereof in an amount of 3 to 30% by weight (paragraph 0018). Clearly, the present invention can be distinguished from Komatsu '871 with regard to **water content**. Further, **Komatsu '871 is silent concerning combined use of the specified amounts of water and carboxylic acid-based electrolyte** to obtain the remarkable effects of the present invention.

Komatsu '871 therefore fails to teach or suggest various features of independent claim 1. Furthermore, at least for the reason disclosed above, claims 3, 5, 7-11, 14-20, 27-28 overcome Komatsu '871 because they depend on independent claim 1.

Accordingly, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn.

3. Claim 1 has been rejected under 35 U.S.C. § 102(b) as being unpatentable over Komatsu (US 6,349,028, hereinafter referred to as Komatsu '028). Applicant respectfully traverses this rejection.

Komatsu '028 teaches an electrolytic solution containing 80 to 20% by weight of water (claim 1). That is, the present invention can be distinguished from Komatsu '028 with regard to **the water content**. This is because Komatsu '028 is directed to inhibiting a concentration of cation of the release paper to not more than 500 ppm. Further, **Komatsu '028 is silent concerning combined use of the specified amount of water and carboxylic acid-based electrolyte**.

Komatsu '028 therefore fails to teach or suggest various features of independent claim 1. Furthermore, at least for the reason disclosed above, claims 3, 5, 7, 10-11, 20, and 25 overcome Komatsu '028 because they depend on independent claim 1.

Accordingly, Applicant respectfully requests that the rejection of claims 1 under 35 U.S.C. § 102(b) be withdrawn.

### **The 103(a) Case Law**

According to Federal Circuit precedent, the burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103 rests squarely on the shoulders of the Examiner. *In re Rinehart*, 531 F.2d 1048, 1052 (C.C.P.A. 1976); *accord*. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references”); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references”); *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination”); *accord*. MPEP 2143.

Second, there must be a reasonable expectation that the proposed modifications or combination would be successful. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375 (Fed. Cir. 1986); *accord*. MPEP 2143.02. Finally, the prior art reference (or references when combined) must teach or suggest each and every claim limitation. *See, e.g., In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *accord*. MPEP 2143.03.

### **35 USC 103 Dependent Rejections**

4. Claims 12-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Komatsu et al (US 6,288,889, hereinafter referred to as Komatsu ‘889) in view of JP 2002-217067. This rejection is improper.

First, the features of independent claim 1, to which claims 12 and 13 are dependant, are not disclosed by Komatsu et al ‘889. Komatsu et al. ‘889 teaches an electrolytic solution for an electrolytic capacitor which comprises a solvent made up of 20 to 80% by weight of an organic solvent and 8 to 20% by weight of water. However, **Komatsu ‘983 is silent concerning use of a carboxylic acid-based electrolyte as a solute in the amount of from 0.5 to 35% by weight of the electrolytic solution.** JP 2002-217067 certainly **is silent concerning use of a carboxylic acid-based electrolyte as a solute in the amount of from 0.5 to 35% by weight of the electrolytic solution.** Since even a combination of the relied upon references would still fail to yield the claimed invention, Applicant submits that a *prima facie* case of obviousness for claims 12-13 have not been presented.

Accordingly, Applicant respectfully requests that the rejection of and claims 12-13 under 35 U.S.C. § 103(a) be withdrawn

5. Claims 21-22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Komatsu ‘871 in view of Hayashi et al (EP 0569938, hereinafter referred to as Hayashi ‘938); Claim 23 has been rejected under 35 U.S.C. § 103 as being unpatentable over Komatsu ‘871 in view of JP 2000-150322; Claim 24 has been rejected under 35 U.S.C. § 103 as being unpatentable over Komatsu ‘871 in view of Takeishi et al (US 6,031,713, hereinafter referred to as Takeishi ‘713); Claim 26 has been rejected under 35 U.S.C. § 103 as being unpatentable over Komatsu ‘871 in view of Poole (US 4,037,142 hereinafter referred to as Poole ‘142).

As previously described Komatsu ‘871 does not disclose, teach or suggest the features **regarding the water content and concerning combined use of the specified amounts of water and carboxylic acid-based electrolyte**, recited in claim 1. Dependent claims 21-24 and 26 depend on independent claim 1 and therefore include the features of independent claim 1.

Application No. 10/580,333  
Amendment dated August 18, 2008  
Reply to Office Action of April 17, 2008

Docket No.: AAO-0276

Even assuming, *arguendo*, that Komatsu '871, Hayashi '938, JP 2000-150322, Takeishi '713 and Poole '142 were combinable, Applicant submits that none of the cited references Hayashi '938, JP 2000-150322, Takeishi '713 and Poole '142, either alone or in any proper combination, cure the deficiencies of Komatsu '871 with respect to at least the previously identified features of claim 1.

Therefore, Applicant respectfully requests that the rejection of claims 21-26 under 35 U.S.C. § 103(a) be withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No., AAO-0276 from which the undersigned is authorized to draw.

Dated: August 18, 2008

Respectfully submitted,

By   
Maulin M. Patel

Registration No.: 56,029  
RADER, FISHMAN & GRAUER PLLC  
Correspondence Customer Number: 23353  
Attorney for Applicant